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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/679,438	10/07/2003	Jeffrey Wyman	A8130.0157/P157	3674

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EXAMINER	
SONNETT, KATHLEEN C	

ART UNIT	PAPER NUMBER
3731	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)
	10/679,438	WYMAN ET AL.
	Examiner	**Art Unit**
	KATHLEEN SONNETT	3731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *19 January 2010*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-5,11 and 12* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☒ Claim(s) *1-5,11 and 12* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/22/2009 has been entered.

Claim Objections

2. Claim 5 is objected to because of the following informalities: "a spring" should read "the spring" since only one spring appears in the embodiment of the device being claimed in claims 1-5 and the spring already appears in claim 1. Appropriate correction is required.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 11 and 12 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 10 of copending Application No. 11/700,915 (US 2007/0179524) in view of Nord (US 6,074,403) and Dingler (US 6,071,299). Claim 10 of ‘915 claims the invention of clam 11 substantially including a shaft, an articulating mechanism, a multi-member pliers-like grip, the grip including a movable handle and a stationary handle extending from the shaft, and a rod extending along the shaft and communicating with a rotary gear mechanism. Claim 10 of '915 fails to claim the following claimed limitations which are taught by Nord and Dingler. Nord teaches having a sharp distal tip at the end of a shaft and it would have been obvious to one skilled in the art to have incorporated such a tip into the device of claim 10 of '915 in order to gain the advantage of being able to capture and retrieve suture from the body. Nord teaches that this tip is in communication with the articulating mechanism to further enhance its capturing qualities. Dingler teaches that a pliers-type grip having a stationary and movable handle may have curved handles. One skilled in the art would have found such a modification obvious since curved handles are well known and are easier to grip. Dingler teaches a spring arrangement that is disposed between the handles in order to urge the instrument into the normally open position. Dingler further teaches that the stationary handle and movable lever are disposed substantially symmetric relative to a longitudinal axis of the instrument when the stationary handle and the movable lever are in a closed position and asymmetrically when the handle and lever are in the open position. It would have been obvious to incorporate the spring as well as the symmetry taught by Dingler into the device of claim 10 of '915 since such a configuration is a well known handle configuration in the art as evidenced by Dingler and the results would have been predictable.

This is a provisional obviousness-type double patenting rejection.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. **Claims 1-5** are rejected under 35 U.S.C. 103(a) as being unpatentable over Nord (US 6,074,403) in view of Miller (US 2,518,994) and Schmidt et al. (US 5,456,684; “Schmidt”) Nord discloses an arthroscopic instrument comprising a shaft having a sharp distal tip (4) for capturing and retrieving suture within a patient’s body, an articulating mechanism (8) disposed on the shaft and in communication with the sharp tip and a handle extending from the shaft. Nord fails to disclose the claimed single lever handle, the rod, and the spring.

6. Miller teaches a handle used to manipulate jaws at the end of a medical instrument wherein the handle (fig. 1) comprises a single lever (25) disposed pivotably on the handle and manipulable by a user's thumb, while the handle is held across the user's palm and the shaft extends distally away from the user's thumb. Miller further teaches that it is well known to use a rod linking an end effector with an actuating lever wherein the lever includes a cam mechanism (surface 27) that engages and cooperates with the rod (17) to move the rod longitudinally within the shaft, thereby actuating the jaws. Miller also teaches a spring (22) that pushes the rod against the cam surface (col. 3, ll. 32-46). It would have been obvious to one skilled in the art to have modified the device of Nord to include a handle with the lever actuator taught by Miller because such a modification can be considered a simple substitution of one known end effector actuating handle for another known end effector actuating handle with predictable results. It would also have been obvious to include a cam surface, push rod, and spring which cause the

articulating mechanism to open and close as taught by Miller since Nord is silent on how movement of the handle is translated to the articulating mechanism and Miller teaches a configuration that is simple in construction, economical to manufacture, and highly efficient in performing its intended function of removing foreign objects from the body (col. 1 ll. 7-12, 42-46). The lever taught by Miller toggles between two positions but these two positions are not symmetric with respect to each other relative to a direction transverse to a longitudinal axis of the shaft. However, such a trigger type lever that toggles between two such symmetric positions is known in the art. For example, Schmidt teaches a trigger lever (31) that toggles between two positions that are symmetric as shown in fig. 2 (note the recess 35 allows for symmetric toggling) in order to control longitudinal movement of an elongated member. It would have been obvious to modify the lever taught by Miller to shape the lever in a similar manner to that disclosed by Schmidt so that it may toggle between the claimed symmetric positions because such a modification can be considered a simple substitution of one known pivoting trigger-type lever for another with predictable results. Furthermore, no criticality is given in the instant specification for this symmetry and it appears that such a change amounts to a mere change in shape and it has been held that, absent persuasive evidence that a particular shape is significant, the shape can be considered a mere design consideration (*In re Dailey,* 357 F.2d 669, 149 USPQ 47 (CCPA 1966)).

7. Regarding claims 2-5, see fig. 1 of Miller. The handle can be considered unitary and extends longitudinally from the shaft (note portion of handle that surrounds rod and shaft). The spring urges the lever into one of the two opposed positions (col. 3, ll. 32-46).

8. Regarding claim 3, the lever can be considered disposed on the top side of the handle since this is dependent on how the instrument is being held. Furthermore, it is noted that a mere

rearrangement of parts of an invention involves only routine skill in the art (*In re Japikse,* 86 USPQ 70).

9. **Claims 11 and 12** are rejected under 35 U.S.C. 103(a) as being unpatentable over Nord in view of Dingler (US 6,071,299). Nord discloses an arthroscopic instrument comprising a shaft having a sharp distal tip (4), an articulating mechanism (8) disposed on the shaft and in communication with the sharp tip and a handle extending from the shaft. Nord fails to disclose the claimed pliers-like grip.

10. Dingler teaches that pliers-like grips on instruments with a moving jaw are well known. Dingler further teaches that it is well known to construct such a grip from one curved movable lever (34) and one curved stationary handle (22) wherein the lever and handle have substantially similar but opposite curved shapes and are substantially symmetric relative to a longitudinal axis of the instrument when in the closed position (fig. 2) and wherein the handle and lever are asymmetrical with respect to the longitudinal axis when they are in the open position (fig. 1). It is noted that the claim includes that the lever and handle are “substantially” symmetric and therefore the handle and lever taught by Dingler meet this limitation, and the open position (fig. 1) is considerably asymmetric as compared to the closed position (fig. 2,5). The handle taught by Dingler also includes a spring arrangement (14) disposed between the curved stationary handle and the curved movable lever to urge the instrument into a normally open position. It would have been obvious to one skilled in the art to have modified the device of Nord to include a handle with the pliers-like grip taught by Dingler because such a modification can be considered a simple substitution of one known end effector actuating handle for another known end effector actuating handle with predictable results. One skilled in the art has good reason to pursue the known technical options within his or her grasp including various known

actuating handles. If this leads to the anticipated success, it is likely the product of ordinary skill and common sense.

Response to Arguments

11. Applicant's arguments filed 12/22/2009 with respect to claims 11 and 12 have been fully considered but they are not persuasive. In particular, Applicant argues that the pliers-type grip taught by Dingler fails to disclose a spring arrangement disposed between the curved stationary handle and the curved movable lever to urge the instrument into a normally open position. This is not found persuasive as Dingler teaches a spring arrangement (14) which is disposed between the two handles and is biased to urge the two handles away from each other. The presence of the ratchet mechanism (15, 16) holds the handles in a certain position against the biasing of the spring but the spring can still be considered to bias the handles away from each other. Dingler discloses that, in order to close the jaws, the movable handle arm (11) is pivoted to its closed position against the effect of the spring (col. 3 ll. 12-18). Therefore, the spring is biasing the handles into their normally open position. Furthermore, the ratchet mechanism may be released by actuating lever (17), at which time the spring biases the handles away from each other into their open position.

12. Applicant's arguments with respect to claims 1-5 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KATHLEEN SONNETT whose telephone number is (571)272-5576. The examiner can normally be reached on 7:30-5:00, M-F, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan Nguyen can be reached on 571-272-4963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

KCS 2/4/2010

/Anhtuan T. Nguyen/
Supervisory Patent Examiner, Art Unit 3731
2/10/10